

## **REMARKS**

Upon entry of this amendment, claims 1-4 are all the claims pending in the application.

Non-elected claims 5-36 are canceled by this amendment.

Applicants note that a number of editorial amendments have been made to the specification for grammatical and general readability purposes. No new matter has been added.

### **I. Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Ueda et al. (U.S. 6,289,102) in view of Aizawa (U.S. 5,646,993). Applicants respectfully traverse this rejection on the following basis.

Claim 1 recites the feature of a playback state obtaining means for monitoring the playback state of a digital medium, wherein a decoding key stored in a key holding means is discarded according to the playback state of the digital medium which is obtained by the playback state obtaining means. Applicants respectfully submit that the combination of Ueda and Aizawa fails to disclose or suggest at least this feature of claim 1.

Ueda discloses a system for preventing unauthorized use of information, the system including a host computer 1, a disk reproducing device 2, and a disk 3 (see Fig. 4). The disk 3 of Ueda includes a lead-in area having key information recorded thereon, and a data recording area having scrambled data stored thereon (see col. 3, lines 45-48). The scrambled data in the data recording area is descrambled based on the key information in the lead-in area (see col. 3, lines 48-50).

In Ueda, in order to display the data recorded in the data recording area of the disk 3, the host computer 1 issues a reproduction only command (i.e., PLAY AV command) to the disk reproducing device 2 via the interface sections 4 and 5 (see col. 9, line 64 through col. 10, line 2). In response to the PLAY AV command, the disk reproducing device 2 transmits the data to the host computer 1 (see col. 10, lines 1-5).

After receiving the data from the disk reproducing device 2, the interface section 4 does not transmit the data to the data bus 9, but instead, transmits the data only to the AV decoder 6 (see Fig. 4 and col. 10, lines 6-9). Thus, because the data is transmitted only to the AV decoder 6, it is impossible to record the data obtained by using the PLAY AV command in a rewritable medium such as a hard disk drive 12 connected to the host computer 1 (see Fig. 4 and col. 10, lines 9-12). Accordingly, in Ueda, in response to a PLAY AV command issued by the host computer 1, the system is able to reproduce scrambled data stored on the disk 3 while preventing the possibility of the data being recorded to an external recording medium.

In the Office Action, the Examiner appears to take the position that issuance of the PLAY AV command by the host computer 1 corresponds to a playback state obtaining means for monitoring the playback state of the digital medium. Applicants respectfully disagree.

In particular, as noted above, while Ueda discloses a host computer 1 that is able to issue a PLAY AV command to a disk reproducing device 2, Applicants respectfully submit that the mere issuance of such a command does not correspond to a playback state monitoring means for monitoring the playback state of the digital medium. In other words, while Ueda discloses the ability to issue a command such as PLAY AV to a reproducing device, wherein the issuance of

the command results in data being transferred to the host computer 1, Applicants respectfully submit that there is absolutely no disclosure in Ueda regarding the monitoring of a playback state, as recited in claim 1.

Further, in the Office Action, the Examiner recognizes that Ueda does not teach the ability to discard a decoding key (see Office Action at page 4). The Examiner, however, applies Aizawa and asserts that this reference teaches a system which erases a decoding key after information has been produced (see Office Action at page 4).

Initially, Applicants note that claim 1 does not merely recite the feature of discarding a decoding key, as appears to be suggested in the Office Action. Instead, claim 1 specifically recites that the decoding key is discarded according to the playback state of the digital medium which is obtained by the playback state obtaining means.

Regarding Aizawa, Applicants note that this references discloses a method for protecting data stored on a recording medium which includes the steps of erasing an encryption key and a decoding program. In Aizawa, information to be protected against a copying operation is enciphered and recorded on an information recording/reproducing section of a disk, and an encryption key 14 and a decoding program 15 are recorded on a ROM section of the disk (see col. 5, lines 30-35).

When information is to be reproduced in Aizawa, the decoding program 15 is reproduced, and the information unit erases the encryption key 14 and the decoding program 15 (see col. 5, lines 35-38). Thus, in Aizawa, if the information on the disk is copied to another disk, the

encryption key 14 and the decoding program 15 are erased, and the decoding program is terminated (see col. 5, lines 39-45).

Accordingly, while Aizawa discloses an encryption key 14 which can be erased, Applicants submit that there is absolutely no disclosure in Aizawa or Ueda which would suggest to one of ordinary skill in the art that an encryption key should be erased in accordance with a playback state of a digital medium.

Therefore, Applicants respectfully submit that even if Ueda and Aizawa were combined, the combination still would not teach or suggest the feature of a playback state obtaining means for monitoring the playback state of a digital medium, wherein a decoding key stored in a key holding means is discarded according to the playback state of the digital medium which is obtained by the playback state obtaining means, as recited in claim 1.

In view of the foregoing, Applicants respectfully submit that the combination of the cited prior art fails to disclose, suggest or otherwise render obvious all of the features recited in claim 1. Accordingly, Applicants submit that claim 1 is patentable over the cited prior art, an indication of which is kindly requested.

Moreover, in the Office Action, Applicants note that the Examiner has not specifically identified the elements in Ueda which allegedly correspond to certain elements recited in claim 1.

For example, regarding the features recited in claim 1 of key obtaining means for performing mutual authentication with the key storage unit to obtain the decoding key stored in the key storage unit, and key holding means for holding the decoding key, wherein the decoding key is obtained by the key obtaining means and stored in the key holding means, Applicants note

that the Examiner has cited passages of Ueda which refer to a mutual authentication key, encrypted disk keys, and a master key (e.g., see col. 17, lines 10-24 and col. 19, lines 15-50).

It is unclear, however, which elements in Ueda the Examiner is alleging correspond to the specific features recited in claim 1. Applicants respectfully submit that neither the mutual authentication key, the encrypted disk keys, nor the master key of Ueda, and the description in Ueda regarding each of these elements, correspond to the features of a key obtaining means for performing mutual authentication with the key storage unit to obtain the decoding key stored in the key storage unit, and key holding means for holding the decoding key, wherein the decoding key is obtained by the key obtaining means and stored in the key holding means, as recited in claim 1.

Accordingly, if the Examiner maintains the rejection of claim 1, Applicants kindly request that the Examiner specifically explain which elements of Ueda are being interpreted as corresponding to the key obtaining means, the decoding key, the key storage unit, and the key holding means, as recited in claim 1.

Claims 2-4 depend from claim 1 and are therefore considered patentable at least by virtue of their dependency.

In addition, regarding claim 2, Applicants note that the Examiner asserts in the Office Action that Ueda discloses a playback state obtaining means for monitoring the playback state of the digital medium. Applicants respectfully submit, however, that the Examiner has not addressed the specific language recited in claim 2.

In particular, Applicants note that claim 2 does not recite the feature of a playback state obtaining means for monitoring the playback state of a digital medium. Instead, claim 2 specifically recites that the decoding key stored in the key holding means is discarded when it is confirmed that the playback state of the digital medium has become "STOP STATE". Applicants respectfully submit that Ueda and Aizawa, either alone or in combination, clearly do not teach or suggest such a feature.

If the Examiner disagrees and believes that the cited prior art teaches the above-noted feature recited in claim 2, Applicants kindly request the Examiner to clearly identify the passages in the prior art that are being relied upon and explain how such passages teach the above-discussed feature.

## **II. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Hirotsugu KAWADA et al.

By: Kenneth Fields  
Kenneth W. Fields  
Registration No. 52,430  
Attorney for Applicants

KWF/abm  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
May 9, 2005